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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,732	01/18/2000	Eric G. Suder	16312-P003D1	1037

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Winstead Sechrest & Minick P.C.
Attention: Kelly K. Kordzik
5400 Renaissance Tower
1201 Elm Street
Dallas, TX 75270-2199

EXAMINER

CHOW, MING

ART UNIT PAPER NUMBER

2645

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/484,732

Applicant(s)

SUDER ET AL.

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-42, 44-52, 54, 55, 57-59, 61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-42, 44-52, 54, 55, 57-59, 61 and 62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 40, 49, 61, 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “call/voice” is not clearly defined.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 40, 49, 55, 61, 62 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

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invention. The phrase “the message does not include a phone number and an identity of a calling party” of claims 40, 49, 55, 61, 62 is not disclosed by the specification. Relative to the current application, a caller can leave a voice message and the voice message can be converted into text and transmitted via caller ID modem. The converted voice message can be displayed on the receiving party’s analog phone set. For a case when the caller leaves a voice message and the voice message contains the caller’s name and telephone number. This voice message, according to the specification of the current application, will be converted into text and displayed on the receiving party’s analog phone. Therefore, the message does include a phone number and an identity of a calling party. The amended limitation is not supported by the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 40-42, 44, 49-52, 54, 55, 58, 61, 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al (US: 5771283), and in view of Alfred et al (US: 5894504) and further in view of Chen (US: 5930346).

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For claims 40, 49, 50, 55, 58, 61, 62, Chang et al teach on item 270 Fig. 2 circuitry coupling the system to an analog telephone extension.

Chang et al failed to teach “a display and a first caller ID modem”. Alfred et al teaches on column 3 line 36-65, a analog telephone with a display for displaying caller-ID information.

Chang et al teach on Abstract – initiating the GID (reads on claimed “creating a message”) and the GID is stored in the module memory.

Chang et al failed to teach “a second caller ID modem”. However, Chen teaches on item 303 Fig. 3 a caller ID generator (claimed “second caller ID modem”) within a central office switch.

Chang et al teach on column 5 line 10-11 origination switch retrieves GID information (reads on claimed “circuitry for retrieving the message from the storing circuitry to the second caller ID modem”).

Chang et al teach on item 270 Fig. 2 switch (claimed “circuitry”) for sending the message from the second caller ID to the first caller ID.

Chang et al teach on Abstract – GID (reads on claimed “the message does not include typical caller ID information”).

It would have been obvious to one skilled at the time the invention was made to modify Chang et al to have the “the analog telephone.....ID modem” and “a second caller ID modem” as taught by Alfred et al and Chen such that the modified system of Chang et al would be able to support the analog telephone with a first caller ID modem, second caller ID modem, and a display to the system users.

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Regarding claims 41, 51, Chang et al teach on Abstract – the GID is retrieved and sent in response to the caller makes a call to the telephone extension.

Regarding claims 42, 52, Chang et al teach on column 6 line 12-17 the GID and caller's directory number are sent to the first caller ID modem while the phone is rung by the system.

Regarding claims 44, 54, Chang et al teach on Fig. 2 circuitry for coupling the system to PSTN and circuitry for receiving the incoming call.

4. Claims 45, 46, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al, in view of Alfred et al, and further in view of Chen as stated above in claim 42, and further in view of Wilson et al (US: 5838772).

Regarding claim 45, Chang et al, , and Chen failed to teach “switching circuitry.....the system”. However, Wilson et al teach on item 34 Fig. 1 switching circuitry, item 10 Fig. 1 voice processing circuitry and both are controlled by item 32 Fig. 1 call control processor (claimed “single processing means”). It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Alfred et al, and Chen to have the “switching circuitry.....the system” as taught by Wilson et al such that the modified system of Chang et al, Alfred et al, and Chen would be able to support the switching circuitry, voice processing circuitry, and both are controlled by a single processing means to the system users.

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Regarding claim 46, the modified system of Chang et al in view of , Alfred et al, Chen, and Wilson et al as stated above in claim 45 failed to teach “the voice.....processing means”. However, Wilson et al teach on Fig. 1 DSP (claimed “signal processing circuitry”) coupled to the single processing means. It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Alfred et al, Chen, and Wilson et al to have the “the voice.....processing means” as taught by Wilson et al such that the modified system of Chang et al, Alfred et al, Chen, and Wilson et al would be able to support the signal processing circuitry to the system users.

Regarding claim 48, the modified system of Chang et al in view of Alfred et al, Chen, and Wilson et al as stated above in claim 45 failed to teach “the single.....processing circuitry”. However, Wilson et al teach on column 2 line 41-43 software facilities. The complete software on the system is considered as a single set of software. It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Alfred et al, Chen, and Wilson et al to have the “the single.....processing circuitry” as taught by Wilson et al such that the modified system of Chang et al, Alfred et al, Chen, and Wilson et al would be able to support the single set of software to the system users.

5. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al, Alfred et al, Chen, and Wilson et al as stated above in claim 46, and in view of McHale (US: 6088430). Chang et al, Alfred et al, Chen, and Wilson et al failed to teach “the switching circuitry further comprises a digital cross-point matrix”. However, McHale teaches on Fig. 4 a switch a cross-

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point matrix. It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Alfred et al, Chen, and Wilson et al to have the “the switching circuitry further comprises a digital cross-point matrix” as taught by McHale such that the modified system of Chang et al, Alfred et al, Chen, and Wilson et al would be able to support the cross-point matrix to the system users.

6. Claims 57, 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al, Alfred et al, and Chen as stated above in claim 55, and in view of Irie et al (US: 5862210).

Regarding claim 57, All rejections as stated in claim 55 above apply. Chang et al, Alfred et al, and Chen failed to teach “converting the.....back into the message”. However, Irie et al teach on column 1 line 39-45 converting the telephone number and the name (claimed “the message”) to tones, transmitting the tones, and converting the tones back to the message. It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Alfred et al, Chen, to have the “converting the.....back into the message” as taught by Irie et al such that the modified system of Chang et al, Alfred et al, Chen, would be able to support the tone conversions to the system users.

Regarding claim 59, the rejections as stated in claim 51 and claim 52 above apply.

Response to Arguments

7. Applicant's arguments filed on 7/21/05 have been fully considered but they are not persuasive.

- i) Applicant argues, on page 8, regarding 35 U.S.C. 112, second paragraph rejection. The claimed “call/voice” is not clearly defined. It is unclear the claimed refers to “call” or “voice”. A “telephone call process” includes call setup, signaling, subscriber management, and others. A “telephone voice process” refers to “voice processing” which may include analog-to-digital conversion. The two limitations are completely different. The MPEP 2173.02 states “If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate.”
- ii) Applicant argues, on page 8, regarding 35 U.S.C. 112, first paragraph rejection. As rejections stated above and previous Office Action, the claimed limitation contradicts what the current application supports.
- iii) Applicant argues, on page 9, regarding “Examiner had agreed to these claim limitations in that telephone conference”. However, the Examiner did not agree with such amendments. See Interview Summary mailed on 11-6-03.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (571) 272-7535. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600. Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks


Washington, D.C. 20231

Or faxed to Central FAX Number 571-273-8300.

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600